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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,510	01/15/2004	Jeffrey Rogers	B-4757NP 621648-9	7058
36716	7590	05/25/2007		
LADAS & PARRY 5670 WILSHIRE BOULEVARD, SUITE 2100 LOS ANGELES, CA 90036-5679			EXAMINER NGUYEN, DUNG T	
			ART UNIT 2828	PAPER NUMBER
			MAIL DATE 05/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,510

Applicant(s)

ROGERS ET AL.

Examiner

Dung (Michael) T. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-39 is/are pending in the application.
- 4a) Of the above claim(s) 35-38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13, 15-34 and 39 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 04/26/07.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

OFFICE ACTION***Response to Arguments***

Applicant first argues that there is no burden because the previously examined claims and the withdrawn claims belong to the same class, 372. This argument is not persuasive. The examiner notes that at present, class 372 contains over 42,000 documents covering all types of lasers. Applicant cannot seriously suggest that, so long as the inventions belong to the same class of 42,000 references, the examiner is under no burden to examine all of the references. The examiner previously described the withdrawn invention as belonging to class 372, subclass 32, a subclass that has not been searched in this application. The examiner previously searched class 372, subclass 6. The need to search this new subclass can be enough to support a "burden" justifying restriction.

Applicant next argues that restriction is improper because it does not satisfy MPEP 808.02, which requires (A) the inventions are classified separately, (B) have a separate status in the art, or (C) require different fields of search. Again, applicant argues that because the distinct inventions both belong to class 372, that none of these are satisfied. Again, the examiner disagrees.

Looking at MPEP 808.02, elements (A) and (C) are defined as follows:

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(A) Separate classification thereof : This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(C) A different field of search : Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes /subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together.

As noted, (A) notes that there is separate classification where the inventions are a separate subject for inventive effort; patents are classified by subclass, therefore each subclass can be deemed a separate subject for inventive effort. (C) gives as an example of different fields of search "searching different classes/subclasses." Additionally, searching is done primarily by subclasses, rather than broadly by class. See Any U.S. Patent, where the "Field of Search" on the face of the patent lists subclasses that were searched. Thus, that the inventions herein belong to different subclasses is enough to show that they have a separate classification, are a separate subject of inventive effort, and require different fields of search. Thus both sections (A) and (C) of MPEP 808.02 appear to be satisfied. This is enough to show that there is a burden in examining both inventions. The restriction requirement of the prior office action, withdrawing claims 35-38 based on an election by original presentation, is still deemed proper and is therefore made final.

Allowable Subject Matter

Claims 1-13, 15-34, and 39 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Communication Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung (Michael) T Nguyen whose telephone number is (571) 272-1949. The examiner can normally be reached on 8:30 - 17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Min Harvey can be reached on (571) 272-1835. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3329.



Michael Dung Nguyen
Primary Examiner

5/9/07